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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,283	02/15/2002	Makoto Iwayama		9044

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EXAMINER

RONES, CHARLES

ART UNIT PAPER NUMBER

2175

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,283

Applicant(s)

IWAYAMA ET AL.

Examiner

Charles L. Rones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Amendment

The amendment timely filed on May 28, 2002 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable by Paulsen, Jr. et al. U.S. Patent No. 6,078,917 ('Paulsen') in view of Rubinstein et al. U.S. Patent No. 5,913,215 ('Rubenstein').

Paulsen discloses:

As to claim 10,

document search method having a function to change over between plural document databases, and a function to search a set of documents having a high relevance to a search input from a selected document database in the order of higher relevance, this input being a set of keywords, fragments of a document or any desired

set of documents, wherein the search results from said document database are used as an input for searching another database; See 4:62-67; 5:56-67; 6:6-67; 7:40-45; 9:1-7; 11:1-7; 12:1-54;14:6-35.

Paulsen discloses the claimed invention except for the wherein the search is used as input to search another plural document databases. teaches that it is known to provide wherein the search is used as input to search another plural document databases. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein the search is used as input to search another plural document databases as taught by Rubinstein, since Rubinstein states at column 19, line 30-65 that such a modification would identifying web pages containing text consistent with the search expressions to continue to communicate with respective search engines to receive identified URLs. See also. Abstract.

As to claim 11,

wherein an interface is provided in which a set of documents from the search result of said selected document database are selected or deselected, and a set of documents selected from the search result are used as an input to perform a search on said another database; See Figs 2-5 and 18-20; 4:1-67; 5:1-38; 6:34-67; 16:38-67; 17:43-67; 18:1-65.

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As to claim 12,

wherein a summary containing only topic words in the search input is used to perform a search; See 4:62-67; 5:56-67; 6:6-67; 7:40-45; 9:1-7; 11:1-7; 12:1-54; 14:6-35.

As to claim 13,

wherein a client transmits a set of documents in a search input to a server where said selected document database is stored, receives a summary comprising only topic words related to the set of documents which is sent, sends a search input corresponding to said summary reflecting a user's evaluation of the summary to a server where said another document database is stored, and receives a search result from a search of said another document database is stored, and receives a search result accordingly; See 4:62-67; 5:56-67; 6:6-67; 7:40-45; 9:1-7; 11:1-7; 12:1-54; 14:6-35.

As to claim 14,

wherein a summary containing only topic words in a search input is used to perform a search; See 4:62-67; 5:56-67; 6:6-67; 7:40-45; 9:1-7; 11:1-7; 12:1-54; 14:6-35.

As to claim 15,

wherein a client transmits a set of documents in a search input to a server where said selected document database is stored, receives a summary comprising only topic

words related to the set of documents which is sent, sends a search input corresponding to said summary reflecting a user's evaluation of the summary to a server where said another document database is stored, and receives a search result from a search of said another document database is stored, and receives a search result accordingly; See 4:62-67; 5:56-67; 6:6-67; 7:40-45; 9:1-7; 11:1-7; 12:1-54; 14:6-35.

As to claim 16,

wherein said server produces a summary from topic words relevant to a set of documents sent by the client and transmits it to the client, and searches and transmits a set of documents having a high relevance to any summary sent by the client, to the client; See 4:62-67; 5:56-67; 6:6-67; 7:40-45; 9:1-7; 11:1-7; 12:1-54; 14:6-35.

As to claim 17,

wherein said client has an interface for specifying a set of documents for search input and document databases to be searched, the set of documents in the search input is sent to a server specified by the user, a summary of the set of documents is received from this server, the summary received is sent to the server comprising said another document database, and search results are received from the latter server and displayed; See 4:62-67; 5:56-67; 6:6-67; 7:40-45; 9:1-7; 11:1-7; 12:1-54; 14:6-35.

As to claim 18,

wherein servers comprising said plural document databases and programs to manipulate said plural document databases are dispersed over a network, a client transmits a set of documents in a search input to a server where a selected document database is stored, receives a summary comprising only topic words related to the set of documents which is sent, sends a search input corresponding to said summary reflecting a user's evaluation of the summary to a server where said another document database is stored, and receives a search result from a search of said another document database; See 4:62-67; 5:56-67; 6:6-67; 7:40-45; 9:1-7; 11:1-7; 12:1-54;14:6-35.

Double Patenting

35 U.S.C. ' 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 10-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 respectively of copending application Serial No. 08/442,147. One set of claims was intended to be an method and the other was intended to be used as a service. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both embody the same methods, which claim the same invention.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Roness whose telephone number is 703-306-3030. The examiner can normally be reached on Monday-Thursday 8am-4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached at 703-305-3830. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.



Charles L. Rones
Examiner
Art Unit 21715

September 19, 2002